

REMARKS/ARGUMENTS

Claims 20-61 are pending. Claims 1-19 are canceled. Claims 24-29, 35, 36, 46-52, and 57-61 are withdrawn pursuant to a Restriction Requirement. Claims 20-23, 30-34, 37-45, and 53-56 are currently under examination and stand substantively rejected. In this Amendment, claims 20, 22, 23, and 41 are amended, claims 30 and 31 are canceled, and new claims 62-68 are added. Reconsideration of the claims is respectfully requested.

Claim Amendments/New Claims

The claim amendments and new claims conform with the Group and Species (i.e. Group II and Species I/Fig. 2) which were elected in response to the Restriction Requirement dated January 9, 2007. Amended claim 20 incorporates elements from canceled claims 30 and 31. Support for amended claims 22, 23, and 40, and new claims 62-68 can be found in the specification at, for example, paragraphs [0033]-[0034] and Fig. 2. No new matter is introduced.

Rejection Under 35 U.S.C. §102

Claims 20-23, 30-34, 37, 39-43, 45, 53-54, and 56 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Publication No. 2003/0010346 to Paolitto et al. ["Paolitto"]. This rejection is traversed.

According to MPEP 2131, in order to anticipate a claim, a reference must teach each and every element of the claim. Paolitto does not meet this test.

Independent Claim 20

Amended claim 20 is directed to a system for enhancing minimally invasive heart surgery. The system includes, among other things, a heart stabilizing device and a first coupling device. The first coupling device includes an elongate shaft having at least one flexible, rigidifying portion that can be rigidified by applying suction.

Paolitto describes a surgical apparatus for transabdominal cardiac surgery. The Office Action alleges that the presently claimed rigidifying portion of the first coupling device is read on by the permanent weir (30) of Paolitto. Applicants disagree. As recited in amended claim 20, the rigidifying portion can be rigidified by applying suction. In contrast, there is no suggestion that Paolitto's permanent weir can be rigidified by applying suction. To the contrary,

Paolitto describes introducing pressurized CO₂ through cannula (10) which is part of weir (30). See Paolitto at paragraph [0056].

Presently pending claims 21, 22, 23, 24, 32-34, 37, 39, and 40 depend directly or indirectly from amended claim 20, and are therefore allowable for depending from an allowable base claim, as well as for the novel combination of elements they recite.

Independent Claim 41

Amended claim 41 is drawn to a device for enhancing minimally invasive heart surgery. The device includes a surgical tool and an elongate coupling member. The elongate coupling member includes an actuation device near the proximal end that can tighten the coupling means to the surgical tool and loosen the coupling means from the surgical tool. Paolitto does not teach or suggest this combination of elements.

Presently pending claims 42, 43, 45, 53-54, and 56 depend directly or indirectly from amended claim 41, and are therefore allowable for depending from an allowable base claim, as well as for the novel combination of elements they recite. Withdrawal of this rejection is respectfully requested.

First Rejection Under 35 U.S.C. §103

Claim 38 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2002/0068855 to Daniel et al. ["Daniel"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Daniel does not meet this test.

Presently pending claim 38 depends indirectly from amended claim 20. As noted above, Paolitto does not teach or suggest a first coupling device which includes an elongate shaft having at least one flexible, rigidifying portion that can be rigidified by applying suction. Daniel discusses an endoscopic retraction system, but does not remedy this deficiency of Paolitto. Thus, the combination of Paolitto and Daniel does not show all elements of amended base claim 20, or claim 38 which depends therefrom. Withdrawal of this rejection is respectfully requested.

Second Rejection Under 35 U.S.C. §103

Claims 44 and 55 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2003/0060685 to Houser et al. ["Houser"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Houser does not meet this test.

Presently pending claims 44 and 55 depend directly or indirectly from amended claim 41. As noted above, Paolitto does not teach or suggest an elongate coupling member which includes an actuation device near the proximal end that can tighten a coupling means to a surgical tool and loosen the coupling means from the surgical tool.

Houser discusses a shape memory tissue stabilizer, but does not remedy this deficiency of Paolitto. Thus, the combination of Paolitto and Houser does not show all elements of amended base claim 41, or claims 44 and 55 which depends therefrom. Withdrawal of this rejection is respectfully requested.

Patentability of New Claims

New claims 62-66 depend directly or indirectly from amended claims 20 or 41, and are therefore allowable as depending from allowable base claims for at least the reasons provided above. New claims 67 and 68 are drawn to systems which includes combinations of coupling devices with rigidifying portions, actuation devices that can tighten and loosen coupling means, and flexible arms that can be rigidified by applying suction. For many of the reasons discussed above, these features are novel and non-obvious over the cited references.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

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